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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/146,952	09/04/1998	ATSUSHI INOUE	040301/0539	1055

7590 05/20/2004

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EXAMINER

DUONG, DUC T

ART UNIT	PAPER NUMBER
2663	16

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/146,952

Applicant(s)

INOUE ET AL.

Examiner

Duc T. Duong

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-24 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 13-15, 17, 18, 29 and 30 is/are rejected.
- 7) ☒ Claim(s) 10, 12, 16, 19-24 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Response to Amendment***

1. In response to the amendment filed on January 28, 2004, claims 9-24 and 29-31 remains pending.
2. Applicant's arguments with respect to claims 9, 11, 13-15, 17, 18, and 30 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 11, 13, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penners et al (U.S. Patent 6,42,616 B1) in view of Falk et al (U.S. Patent 5,668,876).

Regarding to claims 9 and 29, Penners discloses a mobile computer device capable of carrying out communications while moving over inter-connected networks (Fig. 7), the mobile computer device comprising a registration transmission unit (implicitly shown) for transmitting a registration message containing an information on a current location of the mobile computer, from outside a home network of the mobile computer device to a mobile computer management device 142 located at the home network (Fig. 7 col. 9 lines 42-48), the mobile computer management device having a function for managing the information on the current location of the mobile computer

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device and transferring packets destined to the mobile computer device to the current location of the mobile computer device (col. 7 lines 27-29); and an authentication unit (implicitly shown) for authenticating the mobile computer device in response to the registration message (Fig. 7 col. 9 lines 48-54).

Penner fails to teach for a user input unit for transmitting user input information for authentication in response to a challenge message received from the management device requests returning of the user authentication information.

However, Falk discloses an apparatus for authenticating a user comprising a user input unit 21c (Fig. 2) for transmitting user authentication information S20 (Fig. 3 col. 6 lines 19-22) in response to a challenge message received from the management device 26 requests returning of the user authentication information S18 (Fig. 3 col. 6 lines 12-17).

Thus, it would have been obvious to a person of ordinary skill in the art to employ a user input unit as taught by Falk in Penner's system for authenticating a user's identity. The motivation to do so would have been to prevent fraud and theft of services belongs to user.

Regarding to claims 11 and 13, Penner fails to teach the user input based information transmission unit transmits the response message containing a one-time password based on a challenge code contained in the challenge message received from the mobile computer management device as the user input based information. However, Falk discloses transmitting a response code (one-time password) based on a challenge code contained in the challenge message (col. 4 lines 46-49). Thus, it would

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have been obvious to one of ordinary skilled in the art to employ the used of a one-time password as taught by Falk in Penners's system to accommodate the change of password on a periodic or random basis. The motivation to do so would have been to provide additional security.

5. Claims 14, 15, 17, 18, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penners and Falk, futher in view of Schroderus et al (U.S. Patent 5,907,804).

Regarding to claims 14, 15, 17, 18, and 30, Penners and Falk disclose all the limitation with respect to claims 9, except for an external interface unit for reading out desired information from an external memory device connected to the mobile computer device, wherein the external memory device stores at least a user information and a network information to be used for communications at a visited site and a user authentication unit for carrying out first user authentication locally at the mobile computer device according to the user information stored in the external memory device and a user input (claims 14 and 30); the user authentication unit permits reading from the external memory device through the external interface unit when the first user authentication succeeds (claim 15); the user information stored in the external memory device contains a personal information of a user who uses the mobile computer device, and the user authentication unit judges that the first user authentication succeeds when a user authentication information stored in the mobile computer device in correspondence to the personal information stored in the external memory device coincides with the user input as entered by the user at a time of connecting the external

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memory device to the mobile computer device (claim 17); and a reading prohibiting unit for prohibiting subsequent reading from an external memory device through the external interface unit when the first user authentication fails for a prescribed number of times consecutively (claim 18).

However, Schroderus discloses a mobile station includes a user interface 505 (external interface unit) for reading out desired information from a memory means 508 (Fig. 3 col. 9 lines 57-61), wherein the memory means stores at least a user information and a network information (col. 1 lines 50-54); a checking means (user authentication unit for local authentication) for checking the validity of said subscriber according to subscriber identification number pin (user input) and information stored in memory means (Fig. 3 col. 9 lines 61-63); the reading of the SIM card is permits once the authentication is succeed 104 (Fig. 1 col. 6 lines 33-42); the user information stored in the external memory device contains a personal information (PIN) of a user who uses the mobile computer device, and the user authentication unit judges that the first user authentication succeeds when a user authentication information stored in the mobile computer device in correspondence to the personal information stored in the external memory device coincides with the user input as entered by the user at a time of connecting the external memory device to the mobile computer device (Fig. 2 col. 7 lines 38-48); and a blocking means for blocking the reading from the memory means after a predetermined number of fail validation (Fig. 1 col. 7 lines 17-25).

Thus, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to includes the mobile equipment in operation with a SIM card as

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taught by Schroderus in Penners and Falk mobile device with allows a subscriber to use the card to control mobile equipment. The motivation to do so would have been the mobile equipment with the data identifying the user safely in a protected form and to provide services to the mobile equipment.

***Allowable Subject Matter***

6. Claims 10, 12, 16, 19-24, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

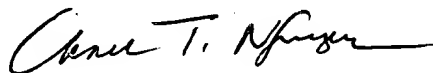
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc T. Duong whose telephone number is 703-605-5146. The examiner can normally be reached on M-Th (9:00 AM-6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on 703-308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DD

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